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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/513,859	02/28/2000	D. Neale BARRET	SJO000031US1	9122

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EXAMINER

FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/513,859

Applicant(s)

BARRET ET AL.

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-17,19-31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-17,19-31 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 29 August 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/03/04 has been entered.

Notice to Applicant

2. This communication is in response to the RCE filed 02/03/04. Claims 1, 3-17, 19-31 and 33-36 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

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ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-17, 19-31 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavin et al (5,772,585) in view of Brown (6,032,119).

(A) As per claim 1, Lavin discloses a method for maintaining electronic patient medical information, comprising:

generating an electronic patient data structure consisting of patient identification information (Col.7, lines 13-67), patient biographical information and one of medical history information including medical event information, medication schedule information, and appointment schedule information (Col.6, lines 58-67 to Col.7, line 67); and log information (The Examiner interprets patient's file as a form of log information Col.9, lines 1-18).

displaying, in the display of the portable computing device, a main menu of selectable views, wherein the selectable views comprise a patient bio view, a medical history view, a patient medication schedule view, an appointment schedule view, and a log view, and wherein the appointment schedule view displayed in the display of the portable computing device differs from the appointment schedule view that is displayable on a display at the physician computer (Col.6, lines 8-67; Col.7, lines 12-67 to Col.8, line 67; Col.14, lines 48-67 to Col.15, line 46), and wherein direct selection of one of the selectable views results in that selected view being displayed independently of the other selectable views (Col.6, lines 8-67; Col.7, lines 12-67 to Col.8, line 67; Col.14, lines 48-67 to Col.15, line 46).

Lavin does not explicitly disclose electronically transmitting the patient data structure between a physician computer and a portable patient device, wherein the patient data structure is capable of being modified.

However, this feature is known in the art, as evidenced by Brown. In particular, Brown suggests electronically transmitting the patient data structure between a physician computer and a portable patient device, wherein the patient data structure is capable of being modified (See, Brown Col.6, lines 7-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system of Lavin with the motivation of providing a system for communicating health information between health providers and patients (See Brown, Col.1, lines 48-50).

(B) As per claim 3, Lavin discloses the method further comprising:

indicating, with the portable patient device, that one scheduled patient medication shown in the patient medication schedule view was taken, wherein the medication schedule view provides a calendar display of a medication schedule derived from prescription subrecords in a patient record (Col.6, lines 58-67 to Col.8, lines 39-67); and

storing the indication that the patient took the scheduled patient medication in the patient data structure in the portable computing device (Col.12, lines 8-50).

(C) As per claim 4, Lavin discloses the method further comprising setting an alarm to activate to provide an alert of one scheduled patient medication or appointment,

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wherein the alarm is set by a patient (Col.13, lines 60-67 to Col.14, lines 48-67) for whom the alert is scheduled and who is using the patient portable device (Col.10, lines 12-67).

(D) As per claim 5, Lavin discloses the method further comprising generating log information indicating modifications to information in the patient data structure, wherein the log information is read-only and once generated cannot be altered (Col.10, lines 50-67).

(E) As per claim 6, Lavin discloses the method further comprising: adding, with the physician computer, one of appointment and medication events to the patient data structure, wherein one appointment event indicates a scheduled medical related visit and one medication event indicates a drug prescription, wherein the drug prescription is digitally signed (Col.13, lines 60-67 to Col.14, line 67 to Col.15, line 42); and transmitting the modified patient data structure to the patient device (Col.4, lines 18-67 to Col.5, line 56).

(F) As per claim 7, Lavin discloses the method wherein the patient device includes a display, further comprising: displaying, in the display of the patient device, in the patient medication schedule view and in the appointment schedule view the added one of appointment and medication events stored in the patient data structure that were added to the patient data structure to allow the patient to review scheduled medication and appointments (Col.14, lines 1-67).

(G) As per claim 8, Brown discloses the method further comprising:

storing, with the physician computer, patient data structures for multiple patients; displaying, at the physician computer, an interactive schedule of patient appointments from the appointment schedule view maintained in the patient data structures, wherein appointment events are added to one patient data structure through the displayed interactive schedule of patient appointments, and wherein the displayed interactive schedule of patient appointments displays scheduled appointments for all patient records (Col.6, lines 7-67).

The motivation for combining the respective teachings of Lavin and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

(H) As per claim 9, Lavin discloses the method wherein the patient data structure further includes patient insurance billing information that can be used to generate insurance claims for patient services (Col.7, lines 25-46).

(I) As per claim 10, Brown discloses the method further comprising using an additional computer to modify information in the patient data structure and transmit the modified patient data structure to the portable patient device (Col.6, lines 7-45).

The motivation for combining the respective teachings of Lavin and Brown are as discussed above in the rejection of claim 1, and incorporated herein.

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(J) As per claim 11, Lavin discloses a medical information system for maintaining electronic patient medical information for use in a physician computer and a portable patient device, the physician computer comprising:

a computer readable medium an electronic patient data structure consisting of patient identification information (Col.4, lines 33-67 to Col.5, line 56), patient biographical information medical, history information including medical event information, medication schedule information, and appointment schedule information (Col.7, lines 13-67 to Col.8, line 58); and log information.....

displaying, in the display of the portable computing device, a main menu of selectable views, wherein the selectable views consist of a patient bio view, a medical history view, a patient medication schedule view, an appointment schedule view, and a log view, and wherein the appointment schedule view displayed in the display of the from the appointment schedule view that is displayable on a display at the physician computer (Col.6, lines 8-67; Col.7, lines 12-67 to Col.8, line 67; Col.14, lines 48-67 to Col.15, line 46), and wherein direct selection of one of the selectable views results in that selected view being displayed independently of the other selectable views (Col.6, lines 8-67; Col.7, lines 12-67 to Col.8, line 67; Col.14, lines 48-67 to Col.15, line 46); and means for modifying information in the patient data structure via at least one of the patient bio view, the medical history view, the patient medication schedule view, and the appointment schedule view (Col.7, lines 13-67).

Lavin does not explicitly disclose at least one communication port capable of transmitting the patient data structure directly to the portable patient device and

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receiving the patient data structure direct from the portable patient device; and wherein the modified patient data structure is capable of being transmitted to the portable patient device via the communication port.

However, these features are known in the art, as evidenced by Brown. In particular, Brown suggests one communication port capable of transmitting the patient data structure directly to the portable patient device and receiving the patient data structure direct from the portable patient device; and wherein the modified patient data structure is capable of being transmitted to the portable patient device via the communication port (See, Brown Col.6, lines 7-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system of Lavin with the motivation of providing a system for communicating health information between health providers and patients (See Brown, Col.1, lines 48-50).

(K) As per claim 12, Lavin discloses the system wherein the physician computer further comprises: means for displaying a the patient medication schedule view and an the appointment schedule view stored in the patient data structure to allow the physician to review scheduled medication and appointments (Col.14, lines 1-67).

(L) As per claim 17, Lavin discloses a medical information system for maintaining electronic patient medical information for use in a physician computer and a portable patient device, wherein the patient device includes: computer readable medium

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including an electronic patient data structure (Col.4, lines 33-67 to Col.5, line 56)consisting of patient information, patient biographical information medical history, information including medical event information, medication schedule information, appointment schedule information (Col.7, lines 13-67 to Col.8, line 58), and log information (The Examiner interprets patient's file as a form of log information Col.9, lines 1-18); and displaying, in the display of the portable computing device, a main menu of selectable views, wherein the selectable views consist of a patient bio view, a medical history view, a patient medication schedule view, an appointment schedule view, and a log view, and wherein the appointment schedule view displayed in the display of the portable computing device differs from the appointment schedule view that is displayable on a display at the physician computer (Col.6, lines 8-67; Col.7, lines 12-67 to Col.8, line 67; Col.14, lines 48-67 to Col.15, line 46), and wherein direct selection of one of the selectable views results in that selected view being displayed independently of the other selectable views (Col.6, lines 8-67; Col.7, lines 12-67 to Col.8, line 67; Col.14, lines 48-67 to Col.15, line 46).

Lavin does not explicitly disclose at least one communication port capable for transmitting the patient data structure to the physician computer and receiving the patient data structure direct from the physician computer, wherein the patient data structure is capable of being modified.

However, these features are known in the art, as evidenced by Brown. In particular, Brown suggests one communication port capable for transmitting the patient data structure to the physician computer and receiving the patient data structure direct

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from the physician computer, wherein the patient data structure is capable of being modified (See, Brown Col.6, lines 7-61).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Brown within the system of Lavin with the motivation of providing a system for communicating health information between health providers and patients (See Brown, Col.1, lines 48-50).

(M) As per claim 19, Lavin discloses the system wherein the portable patient device further comprises: means for indicating that one scheduled patient medication was taken, wherein the medication schedule view provides a calendar display of a medication schedule derived from prescription subrecords in a patient record (Col.6, lines 58-67; Col.15, lines 1-67); and means for storing the indication in the patient data structure that the patient took the scheduled medication (Col.15, lines 25-58).

(N) As per claim 20, Brown discloses the system wherein the portable patient device further comprises means for setting an alarm to activate to provide an alert of one scheduled patient medication or appointment, wherein the alarm is set by a patient for whom the alert is scheduled and who is using the patient portable device (Col.)...

(O) As per claim 23, Lavin discloses the system further comprising an additional computer, wherein the additional computer includes: means for transmitting the electronic patient medical information between the additional computer and the portable

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patient device, wherein the additional computer is capable of modifying information in the patient data structure via at least one of the patient bio view, the medical history view, the patient medication schedule view, and the appointment schedule view and transmitting the modified patient data structure to the portable patient device (Col.6, lines 58-67 to Col.7, line 67).

(P) As per claim 24, Lavin discloses the system wherein the portable patient device comprises one of a smart card, palm computing device, hand-held computing device, and laptop computer (Col.4, lines 45-59).

(Q) Claim 25 differs from claims 1, 11 and 17 by reciting an article of manufacture embodied on a computer-readable medium for use in a medical information system to maintain electronic patient medical information for use in a physician computer and a portable patient device, the article of manufacture comprising at least one computer program capable of causing the physician computer to perform.

As per this limitation, it is noted that Lavin discloses reading an electronic patient data structure consisting of patient identification information, patient biographical information, medical history information including medical event information, medication schedule information, appointment schedule information (Col.7, lines 13-67 to Col.8, line 67); and log information (The Examiner interprets patient's file as a form of log information Col.9, lines 1-18); displaying, in the display of the portable computing device, a main menu of selectable views, wherein the selectable views consist of a

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patient bio view, a medical history view, a patient medication schedule view, an appointment schedule view, and a log view, and wherein the appointment schedule view displayed in the display of the portable computing device differs from the appointment schedule view that is displayable on a display at the physician computer (Col.5, lines 28-67 to Col.6, line 67; Col.8, lines 9-67); and modifying information in the patient data structure via at least one of the patient bio view, the medical history view, the patient medication schedule view, and the appointment schedule view (Col.7, lines 13-67) and wherein direct selection of one of the selectable views results in that selected view being displayed independently of the other selectable views (Col.6, lines 8-67; Col.7, lines 12-67 to Col.8, line 67; Col.14, lines 48-67 to Col.15, line 46).

Brown discloses transmitting the patient data structure to the portable patient device; receiving the patient data structure from the portable patient device; and wherein the modified patient data structure is capable of being transmitted to the portable patient device via the communication port.

Thus, it is readily apparent these prior art systems utilize an article of manufacture embodied on a computer-readable medium for use in a medical information system to perform their specific function.

The remainder of claim 25 is rejected for the same reason given above in claims 1, 11, and 17, and incorporated herein.

(R) As per claim 26, Lavin discloses the article of manufacture further causing the physician computer to perform: displaying views of the patient medication and

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appointment schedule information stored in the patient data structure to allow the physician to review scheduled medication and appointments (Col.13, lines 60-67 to Col.14, line 67).

(S) Claim 31 differs from claims 1, 11, 17, and 25 by reciting an article of manufacture embodied on a computer-readable medium for use in a medical information system to maintain electronic patient medical information for use in a physician computer and a portable patient device, the article of manufacture comprising at least one computer program capable of causing the portable patient device to perform:

As per this limitation, it is noted that Lavin discloses storing an electronic patient data structure including patient biographical information and one of medical history information including medical event information, medication schedule information, and appointment schedule information (Col.7, lines 13-67 to Col.8, line 67) and

displaying, in the display of the portable computing device, a main menu of selectable views, wherein the selectable views comprise a patient bio view, a medical history view, a patient medication schedule view, an appointment schedule view, and a log view, and wherein the appointment schedule view displayed in the display of the portable computing device differs from the appointment schedule view that is displayable on a display at the physician computer (Col.5, lines 28-67 to Col.6, line 67; Col.8, lines 9-67) and Brown discloses transmitting the patient data structure to the

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physician computer; receiving the patient data structure from the physician computer, wherein the patient data structure is capable of being modified.

Thus, it is readily apparent these prior art systems utilize an article of manufacture embodied on a computer-readable medium for use in a medical information system to perform their specific function.

The remainder of claim 31 is rejected for the same reason given above in claims 1, 11, 17, and 25, and incorporated herein.

(T) As per claim 33, Lavin discloses the article of manufacture further causing the patient device to perform: indicating that one scheduled patient medication was taken, wherein the medication schedule view provides a calendar display of a medication schedule derived from prescription subrecords in a patient record (Col.6, lines 58-67; Col.13, lines 60-67 to Col.14, line 65) and storing the indication in the patient data structure that the patient took the scheduled medication (Col.12, lines 8-26).

(U) Claims 13-16, 20-22, 27-30 and 34-35 recite the underlying process of the elements of claims 4-9, respectively. As the various elements of claims 4-9 have been shown to be either disclosed by or obvious in view of the collective teachings of Lavin and Brown, it is readily apparent that the apparatus by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 13-16, 20-22, 27-30 and 34-35 are rejected for the same reasons given above for method claims 4-9, and incorporated herein.

(V) As per claim 36, Lavin discloses the article of manufacture further causing the patient device to perform: transmitting the electronic patient medical information to an additional computer, wherein the additional computer is capable of modifying information in the patient data structure via at least one of the patient bio view, the medical history view, the patient medication schedule view, and the appointment schedule view and transmitting the modified patient data structure to the portable device (Col.6, lines 58-67 to Col.7, line 67).

Response to Arguments

5. Applicant's arguments filed on 02/03/04 regarding claims 1, 3-17, 19-31 and 33-36 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 02/03/04.

(A) At pages 13-17 of the 02/03/04 response, Applicant argues that the features in the 02/03/04 amendment are not taught by or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 02/03/04 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Lavin and/or Brown based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present

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Office Action and in the prior Office Action (paper number 17), and incorporated herein.

One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not relied upon art teaches medical records, documentation, tracking and order entry system (5,823,948) and chronic disease monitor (6,277,071).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone

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numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F.
V.F.

April 12, 2004

*Alfredo Lafont
Alexander Hernandez
Primary Examiner
Art 3626*